



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,828	04/03/2001	James Wickstead	JWD-PT002	1198
3624	7590	11/04/2004	EXAMINER	
VOLPE AND KOENIG, P.C. UNITED PLAZA, SUITE 1600 30 SOUTH 17TH STREET PHILADELPHIA, PA 19103			PERSINO, RAYMOND B	
			ART UNIT	PAPER NUMBER
			2682	

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/824,828

Applicant(s)

WICKSTEAD, JAMES

Examiner

Raymond B. Persino

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 9, 11-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over MOONEY (US 2002/0132582 A1) in view of JEON et al (US 6,549,791 B1).

Regarding claim 1 (Rejection Maintained, error corrected), MOONEY discloses a wireless apparatus for communicating with a remote location through a wireless network, comprising: first (element 104 of figure 1) and second (element 102 of figure 1) units each having a low-power transceiver for wireless communication over a low power radio link; said first unit having a second transceiver for wireless communication with said remote location, said second transceiver having a transmission range greater than said low-power transceiver; coupling electrical signals to the low-power transceiver in said second unit for transmission to said first unit through said low-power radio link; and that the first and second units have a convention cellular telephone front end (paragraphs 26-46). However, MOONEY does not explicitly disclose that the second unit being smaller than said first unit and being of a size so as to be worn or carried on the body of a user; said second unit having a key pad for inserting calling data; a display

Art Unit: 2682

in said second unit displaying calling data; said second unit having a microphone for converting speech into electrical signals and a speaker for converting electrical signals into speech and a controller for controlling operations of said display, speaker and microphone. JEON et al discloses wireless apparatus being of a size so as to be worn or carried on the body of a user; said second unit having a key pad (element 101/108 of figure 1) for inserting calling data; a display (element 102 of figure 1) in said second unit displaying calling data; said second unit having a microphone (element 105 of figure 1) for converting speech into electrical signals and a speaker (element 106 of figure 1) for converting electrical signals into speech and a controller (inherent) for controlling operations of said display, speaker and microphone (column 5 line 4 to column 6 line 10). Therefore it would have been obvious to a person of ordinary skill in the art at the time of the Applicant's invention to have the structure of second unit be of a size so as to be worn or carried on the body of a user. This structure is advantageous in terms of miniaturization thereof. Further, it minimizes the likelihood of it being dropped.

Regarding claim 2 (Rejection Maintained), see the rejection of the parent claim concerning the subject matter this claim depends from. MOONEY further discloses that said first unit comprises a controller (inherent) for transferring signals received by the low-power transceiver in said first unit to said second transceiver for transmission to said remote location (paragraphs 26-46).

Regarding claim 3 (Rejection Maintained), see the rejection of the parent claim concerning the subject matter this claim depends from. MOONEY further discloses that the controller (inherent) in said fist unit further includes means for transferring signals

Art Unit: 2682

from said second transceiver to the low-power transceiver in said first unit for transmission over said low-power radio link to said second unit (paragraphs 26-46).

Regarding claim 4 (Rejection Maintained), see the rejection of the parent claim concerning the subject matter this claim depends from. MOONEY further discloses that said low-power transceivers both operate at a specific carrier frequency to prevent receipt of a transmission from a transmitter other than the low-power transceivers in said first and second units (paragraph 23)

Regarding claim 5 (Rejection Maintained), see the rejection of the parent claim concerning the subject matter this claim depends from. MOONEY further discloses that the transmission range of said low-power transceiver is less than 100 feet (paragraph 23). The reference states 20 to 100 foot range as a maximum distance.

Regarding claim 6 (Rejection Maintained), see the rejection of the parent claim concerning the subject matter this claim depends from. MOONEY further discloses that the transmission range of said low-power transceiver is less than 20 feet (paragraph 23). The reference states 20 to 100 foot range as a maximum distance.

Regarding claim 9 (Rejection Maintained), see the rejection of the parent claim concerning the subject matter this claim depends from. MOONEY further discloses that said second transceiver is a digital wireless transceiver (paragraphs 48). Alternatively, JEON et al further discloses that said second transceiver is a digital wireless transceiver (column 1 line 15).

Regarding claim 11 (Rejection Maintained), see the rejection of the parent claim concerning the subject matter this claim depends from. JEON et al further discloses

Art Unit: 2682

that said microphone and speaker are combined into one unit (the wrist phone, see figure 1).

Regarding claim 12 (Rejection Maintained), see the rejection of the parent claim concerning the subject matter this claim depends from. JEON et al further discloses that a stylus is provided for operating said keypad (see the touch pen of figure 29, it may be used to press a key).

Regarding claim 13 (Rejection Maintained), see the rejection of the parent claim concerning the subject matter this claim depends from. JEON et al further discloses that the second unit is worn on a wrist of the user (column 5 line 4 to column 6 line 10).

Regarding claim 14 (Rejection Maintained), see the rejection of the parent claim concerning the subject matter this claim depends from. JEON et al further discloses the second unit is affixed to an article of clothing of the user (a wristband is an article of clothing, column 5 line 4 to column 6 line 10).

Regarding claim 16 (Rejection Maintained), see the rejection of the parent claim concerning the subject matter this claim depends from. MOONEY further discloses that the first unit is maintained at a greater distance from the user's head than said second unit to reduce possible harm due to radiation emitted by said first unit (paragraph 44).

3. Claims 7, 8, 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over MOONEY (US 2002/0132582 A1) in view of JEON et al (US 6,549,791 B1) and further in view of an examiner's official notice.

Regarding claim 7 (Rejection Maintained), see the rejection of the parent claim concerning the subject matter this claim depends from. JEON et al further discloses

Art Unit: 2682

that the second unit is powered by portable batteries (element 22 of figure 1), the battery source in said second unit being small and low powered to reduce the overall size of said second unit (column 6 lines 11-20). However, the prior art used in the rejection of the parent claim does not disclose that the first unit is powered by a portable battery. Nevertheless, the examiner takes official notice that it is known to power a wireless apparatus with a portable battery. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use portable batteries in a wireless apparatus. This allows the wireless apparatus to be powered for wireless use.

Regarding claim 8 (Rejection Maintained), see the rejection of the parent claim concerning the subject matter this claim depends from. However, the prior art used in the rejection of the parent claim does not disclose that said low powered transceivers encode their transmissions to prevent interception by other transceivers. Nevertheless, the examiner takes official notice that it is known for Bluetooth communications to be encoded. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made for Bluetooth communications to be encoded. This enables the encoded communications to be private.

Regarding claim 10 (Rejection Maintained), see the rejection of the parent claim concerning the subject matter this claim depends from. However, the prior art used in the rejection of the parent claim does not disclose that a key pad and display are eliminated from said first unit to reduce electronic components employed in said first unit. Nevertheless, the examiner takes official notice that it is known for a wireless

Art Unit: 2682

portable repeater to lack a key pad and display. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made for a wireless portable repeater to lack a key pad and display. If a wireless apparatus is used as a repeater, then a key pad and display would not be needed. Thus, it would be beneficial to not include them in the construction of the wireless portable repeater, in that it would save money.

Regarding claim 15 (Rejection Maintained, language made consistent with amendment to claim), see the rejection of the parent claim concerning the subject matter this claim depends from. However, the prior art used in the rejection of the parent claim does not explicitly disclose that the second unit is of a size to enable it to be placed within a pocket of an article of clothing of the user. Nevertheless the examiner takes official notice that something that worn on a wrist of the user would be of a size to enable it to be placed with a pocket of an article of clothing of the user. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made for the second unit to be of a size to enable it to be placed with a pocket of an article of clothing of the user. Having the device intended to be worn on the wrist be small enough to be placed with a pocket of an article of clothing of the user ensures that the device will be of a size that is comfortable when worn.

Response to Arguments

4. Applicant's arguments filed 6/25/2004 have been fully considered but they are not persuasive.

Art Unit: 2682

Regarding claim 1, the applicant makes three arguments. First, the applicant argues that gateway cell phone 104 in the '582 publication has all the capabilities of a regular cell phone while in the present invention those capabilities are built only into the miniature unit. In response, it is noted that the features upon which applicant relies (i.e. regular cell phone capabilities being built only into the miniature unit) are not recited in claim 1. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is noted however that this argument may be applicable to claim 10, see the examiner's rejection of claim 10 above.

In response to applicant's argument that '582 teaches of an apparatus having objectives which are directly opposite the present invention, namely to have the "master" cellular device be the smaller of the two devices, the examiner disagrees. Given two cell phones having the same cell phone capabilities doesn't necessitate that the cell phones be of the same size. A given component, such as a display or a keyboard, can be made in a variety of ways yielding components with the same function but taking up a different amount of space. By way of example, consider the range of sizes in cell phones offered in the market that each have the same capabilities. Moreover, '582 is silent as to the relative sizes of 102 and 104. Thus, the examiner does not conclude that because '582 teaches of 102 and 104 both having regular cell phone capabilities, that they couldn't be different sizes. Thus, '582 does not teach away from the combination.

Art Unit: 2682

Lastly, in response to the applicant's argument that '791 teaches away from the present invention, it is noted that the features upon which applicant relies (i.e. certain capabilities being built only into the low power unit) are not recited in claim 1. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is noted however that this argument may be applicable to claim 10, see the examiner's rejection of claim 10 above.

Regarding claim 2, the applicant makes the argument that the "first unit" of '582 communicates directly with the remote location whereas, in the present invention, the "first unit" communicates with the remote location only through a second unit. However, the claim language does not permit the interpretation of the "first unit" communicating with a remote location only through a second unit. On the contrary, the claim includes the subject matter of the "second unit" communicating via the "first unit" to the remote location as taught by '582.

Regarding claim 3, the applicant makes the argument that it is the "second unit" of '582 that directly communicates with the remote location. However, in '582 the "second unit" communicates via the "first unit".

Regarding claim 11, the applicant makes the argument that '582 doesn't disclose a speaker and microphone in a single unit. However, the examiner has relied upon '791 for this teaching. In '791, a speaker and microphone are combined in body element 10 (see column 6 lines 2-4).

Regarding claim 7, the applicant makes the argument that '791 doesn't teach that the batteries are "in" the unit. Nevertheless, the examiner is interpreting the battery pack holder (20) and body element (10) to makeup the unit. Thus, under this interpretation, the battery is in the unit.

Regarding claim 10, the applicant makes the argument the examiner's official notice teaches away from the combination of '582 and '791 because '582 teaches that the "first unit" has a keypad and display since it must be capable of making a determination as to where a call comes in from and where to forward it. However, nothing in '582 requires that the "first unit" have a display and keyboard. For example, the authorized terminal list may be maintained by the manufacture and not necessarily by the gateway owner (see paragraph 40). Thus it would not destroy the teaching for the "first unit" to be without a display and keyboard.

Regarding claims 4, 5, 6-9 and 12-16, the applicant makes the argument that the claim is allowable due to their dependence on claim 1. However, the rejection of claim 1 has been maintained.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

Art Unit: 2682

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond B. Persino whose telephone number is (703) 308-7528. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian C. Chin can be reached on (703) 308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Raymond B. Persino
Examiner
Art Unit 2682

KP

RP


VIVIAN CHIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600